

REMARKS/ARGUMENTS

Claims 1 and 19-36 are pending. Claims 2-18 were previously canceled. All pending claims stand substantively rejected. Reconsideration of the claims is respectfully requested.

Rejection Under 35 U.S.C. §102

Claims 1, 20-23, 25, 30, and 35 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 4,818,517 to Kwee et al. ["Kwee"]. Applicants traverse this rejection.

According to MPEP 2131, to anticipate a claim, a cited reference must teach every element of the claim. Kwee fails to meet this test as applied to the subject claims.

Independent claims 1 and 35 are drawn to an extrudable hydrogel that is substantially free from a free aqueous phase. As noted in the instant specification, the hydrogel itself can be conveniently extruded by a syringe and applied onto and conformed to sites such as intervertebral spaces and tissue divots.

Kwee fails to disclose an extrudable hydrogel that is substantially free from a free aqueous phase, as described in presently pending claims 1 and 35. In fact, Kwee describes a hydrogel that contains free water and is difficult to extrude through a syringe.

It turned out in particular that a hydrogel or suspension obtained on the basis of an insoluble but swellable polymer cannot be homogeneously and/or fully "synged out" presumably because the pressure exerted on the gel or suspension presses water out of the gel or suspension. (See Kwee at col. 1, lines 35-40).

To address the problem, Kwee simply proposes adding a thickening agent to improve the syringeability of *the original hydrogel* which still contains free water (Kwee at col. 1, lines 45-48; emphasis added). Absent evidence to the contrary, Applicants understand Kwee as describing the addition of a water-soluble viscosity-enhancing agent to render the free water in their hydrogel more viscous. Yet there is nothing to suggest that the thickening agent somehow provides a hydrogel that is substantially free from a free aqueous phase, as presently claimed.

In reference to Kwee's second embodiment (Kwee at col. 1, line 58 to col. 2, line 8), the Office Action alleges that "the composition of Kwee does not contain any free aqueous phase other than the water that forms a part of the hydrogel." Applicants find no support for this conclusion. The second embodiment includes two compartments. The first compartment contains dry polymer particles. The second compartment contains water. These two compartments can be mixed to create a hydrogel, yet there is nothing in Kwee to suggest that the result will be a hydrogel that is substantially free from a free aqueous phase, as presently claimed. Applicants submit that Kwee's hydrogel still contains free water, albeit a more viscous free water due to the addition of a water-soluble thickening agent.

Based on the above, Kwee fails to teach or suggest each of the elements of independent claims 1 and 35, and therefore does not anticipate these claims. Claims 20-23, 25, and 30 depend either directly or indirectly from claim 1, and are therefore allowable as depending from an allowable base claim, as well as for the novel combination of elements they recite. Withdrawal of this rejection is respectfully requested.

First Rejection Under 35 U.S.C. §103

Claims 19, 24, 31, 32, and 36 were rejected under 35 U.S.C. §103(a) as allegedly obvious over U.S. Patent No. 4,818,517 to Kwee et al. ["Kwee"]. Applicants traverse this rejection.

MPEP 2143 requires that to establish a *prima facie* case of obviousness, among other things, the cited reference must teach or suggest all the claim elements. As noted above, Kwee fails to teach or suggest each and every element of presently pending independent claim 1, and for many of the same reasons, Applicants submit that Kwee fails to anticipate presently pending independent claim 36, which recites a hydrogel which is substantially free from a free aqueous phase. Further, the Action has not established the existence of knowledge generally available in the field that would prompt the artisan to modify Kwee to arrive at the presently claimed hydrogel of claims 1 and 36.

Claims 19, 24, 31, and 32 depend either directly or indirectly from claim 1, and are therefore allowable as depending from an allowable base claim, as well as for the nonobvious combination of elements they recite. Withdrawal of this rejection is respectfully requested.

Second Rejection Under 35 U.S.C. §103

Claims 26-29, 33, and 34 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 4,818,517 to Kwee et al. in view of Berg et al. Applicants traverse this rejection.

Although the Action does not specify which Berg et al. reference to which it refers, Applicants assume it is U.S. Patent No. 4,837,285 to Berg et al. ["Berg"]. Clarification is requested.

MPEP 2143 requires that to establish a *prima facie* case of obviousness, among other things, the cited references when combined must teach or suggest all the claim elements.

As noted above, Kwee fails to teach or suggest each and every element of presently pending independent claim 1, and for many of the same reasons, Applicants submit that Kwee fails to anticipate presently pending independent claim 34, which recites a hydrogel which is substantially free from a free aqueous phase. Berg fails to remedy the deficiencies of Kwee, because Berg fails to teach or disclose a hydrogel which is substantially free from a free aqueous phase as presently claimed.

Claims 26-29 and 33 depend either directly or indirectly from claim 1, and are therefore allowable as depending from an allowable base claim, as well as for the nonobvious combination of elements they recite. Withdrawal of this rejection is respectfully requested.

Appl. No. 09/553,969
Amdt. dated February 14, 2005
Reply to Office Action of November 12, 2004

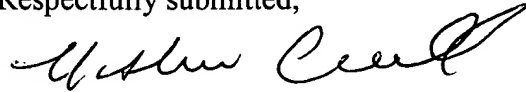
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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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